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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/750,105	12/29/2000	James M. Rogers	20009.0050US01 (BS00-139)	6282
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WITHERS & KEYS FOR BELL SOUTH P. O. BOX 71355 MARIETTA, GA 30007-1355			EXAMINER BELIVEAU, SCOTT E	
			ART UNIT	PAPER NUMBER
			2623	
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			01/15/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

09/750,105

Applicant(s)

ROGERS ET AL.

Examiner

Scott Beliveau

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3, 6-11 and 21 is/are pending in the application.
- 4a) Of the above claim(s) 21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 6-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10 October 2007 has been entered.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 1-3 and 7-11 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-3 and 6-11 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Amended claim 1 requires “assigning a weighting to at least two classifications for each of the plurality of advertisements . . . searching the data table for the stored advertisement having the at least one classification . . . [and] if the search by classification produces more than one stored advertisement, then selecting the stored advertisement to be inserted by comparing each of the at last two classifications weightings in the table for each of the stored advertisements that were produced by the search”. Claim 11 notes that the “weighted classifications . . . include one or more of: sponsor name; type of product advertised; relative pricing of product advertised and location of sponsor”. Accordingly, the claim requires that the system match a given classification (ex. product type – Home Improvement or Alcohol), have multiple matches (Home Improvement commercial or Alcohol commercial), (Figure 6) and then use a product type assigned weighting to decide which particular product type commercial to select.

Applicants note that support for the amendment may be found on page 17 of the specification. Page 17 of the specification describes the usage of a determination algorithm that includes a ‘weighting feature’ for determining priority based on the frequency by which a commercial has been inserted, the price paid by an advertiser, the expiration date of the advertising contract, and the correlation between the product advertised in the commercial and the subject matter of the television program. These ‘weighing features’ appear to only correspond to “sub-classifications” (claim 7). Subsequent to locating at least one advertisement that matches insertion criteria, the system utilizes weightings of ‘sub-classifications’ to compare (prioritize) advertisements matching the selected ‘classification’. Consequently, the specification does not provide adequate written description support for

“assigning a weighting to at least two classifications for each of the plurality of advertisements . . . [and] comparing each of the at least two classification weightings” as claimed.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
7. Claim 1-3 and ~~6~~-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zigmond et al. (US Pat No. 6,698,020) in view of Knee et al. (US Pub No. 2002/0095676 A1).

Regarding claim 1, Zigmond et al. discloses a “method for inserting targeted advertisements into a media delivery stream during broadcast media program” using the apparatus of Figure 3. As illustrated in Figure 5, the method comprises “storing data files

representing a plurality of advertisement in a media delivery device” [80] in a “database” [86] or organized data structure containing a number of records in the form of advertisements wherein the “stored advertisements are each of a type that is determined to appeal to one or more users of the media delivery device” (Col 12, Lines 15-24; Col 13, Lines 7-12). The apparatus “receives a signal in the media delivery device” associated with the vertical blanking interval “to insert a stored advertisement into the media delivery stream during broadcast media programming wherein the signal to insert the stored advertisement is sent with the broadcast media programming” (Col 15, Lines 35-65). The ‘signal’ associated with the vertical blanking interval also “includes at least one classification of the plurality of classifications” for selecting a commercial stored in the database for insertion into the media delivery stream (Col 11, Lines 31-49; Col 11, Line 66 – Col 12, Line 32; Col 16, Lines 43-56). The apparatus “searches . . . for the stored advertisement having the at least one classification that is provided in the signal” and “inserts [the selected] advertisement stored in the database into the media delivery stream” (Col 15, Lines 56-65). Subsequently, the system “transmits a request from the media delivery device to an external network through a telecommunications link to receive the plurality of advertisements for storage in the media delivery device” (Col 15, Lines 2-16).

In selecting an advertisement for insertion, the Zigmond et al. reference contemplates that a “search by classification [may] produce more than one stored advertisement” whereupon the system selects one advertisement for insertion (Col 16, Line 65 – Col 17, Line 9). Part of the selection criteria may include demographic information (Col 14, Lines 34-48). Zigmond et al., however, is silent with respect to the particular usage of ‘weighting’ in

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selecting between multiple advertisements that match a given category. In an analogous art pertaining to the problem of advertisement insertion, the Knee et al. reference discloses “creating a record in a data table associated with each of [a] plurality of advertisements [wherein] the data table includes a plurality of classifications [or demographic categories] for each of the plurality of advertisements” and “assigning a weighting to at least two classifications for each of the plurality of advertisements” (Figure 2). Subsequently, the system “searches the data table . . . [and] if the search by classification produces more than one stored advertisement, then selecting the stored advertisement to be inserted by comparing each of the at least two classification weightings in the table for each of the stored advertisements that were produced by the search” ; Para [0029] – [0034], [0046], [0047], and [0049]). For example, even though both advertisements match being for ‘sports fans’ a closest match fit would result in the selection of advertisement #2. As evidenced by Knee et al., the technique of categorization ‘weighting’ for selecting between advertisements that meet a desired classification in order to choose the best advertisement for display was part of the ordinary capabilities of a person of ordinary skill in the art. Therefore, it would have been obvious to one having ordinary skill in the art to utilize the known technique with Zigmond et al. so as to refine its advertisement selection process using demographic information (Knee et al.: Para. [0007] - [0008]).

Claim 2 is rejected wherein the “advertisements are television commercials” (Zigmond et al.: Col 1, Lines 14-22; Col 7, Lines 13-25).

Claim 3 is rejected wherein the “media delivery device is a set top box for receiving broadcast signals for a cable or satellite television network system” (Zigmond et al.: Col 7, Lines 1-12 and 37-51).

Claims 6 and 7 are rejected wherein the method further comprises the “creating and weighting a sub-classification for each classification” in accordance with the advertisement selection rules [83] (i.e. a given rule specifying a particular criterion defines an absolute weight) (Zigmond et al.: Col 11, Lines 31-49) wherein the “sub-classifications include at least two of: a frequency by which each resulting commercial has been inserted [and] a correlation between a product being advertised and the type of a television program” (Zigmond et al.: Col 12, Lines 60 – Col 13, Line 6; Col 13, Line 40-47).

Claim 8 is rejected wherein the “plurality of stored advertisements are received by the media delivery device as encoded data files through the telecommunications link to an external database of advertisements” (Zigmond et al.: Col 14, Line 66 – Col 15, Line 17; Col 15, Lines 24-34).

Claim 9 is rejected wherein the method further comprises “transmitting signals between the media delivery device and the external network indicating the one or more types of advertisements that appeal to users of the media delivery device” (Zigmond et al.: Col 9, Lines 21-38) and “classifying the stored advertisements according to a plurality of categories, which includes a classification according to the type of advertisement that is stored” (Zigmond et al.: Col 11, Lines 37-42; Col 12, Lines 26-33).

Claim 10 is rejected wherein “after transmitting the request, receiving download signals from the broadcast media stream in the media deliver device to download the data files



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representing the advertisements for storage in the media delivery device, wherein for each advertisement the signals include a classification as provided in the table for selecting an advertisement stored in the database for insertion into the media delivery stream” (Zigmond et al.: Col 12, Lines 26-33; Col 14, Line 66 – Col 15, Line 16) and “downloading the data files representing the advertisements having a classification as provided in the table that matches a pre-stored classification in a list of classification indicating the one or more types of advertisements that appeal to users of the media delivery device” (Zigmond et al.: Col 14, Lines 24-27; Col 15, Lines 17-23).

Regarding claim 11, the combined references are silent with respect to the ‘demographic information’ of Knee further including a category for location of sponsor’ type of product advertised”. Zigmond et al. discloses targeting advertisements based on location (Zigmond et al.: Col 14, Lines 48-53). The examiner takes OFFICIAL NOTICE that location information as a demographic classifier is notoriously well known in the art. Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the combined references such that the “weighted classifications in the table include . . . location of sponsor” for the purpose effectively targeting advertisements to those most likely interested in the products or services they offer (Knee et al.: Para. [0007]). For example, a west coast chain of automobile dealerships would not likely be patronized by a east coast resident. Therefore, an advertisement for that west coast dealership would not be as effective on the east coast.

### *Conclusion*

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Beliveau whose telephone number is 571-272-7343.

The examiner can normally be reached on Monday-Friday from 8:30 a.m. - 6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 571-272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



SEB

January 14, 2008

Scott Beliveau  
Primary Examiner  
Art Unit 2623